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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. KREIDER and BARBARA A. ROY

Appeal 2008-2921
Application 09/704,066
Technology Center 2100

Decided¹: March 27, 2009

Before LEE E. BARRETT, JOSEPH L. DIXON, and
ST. JOHN COURTEMAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-27. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

A. INVENTION

The invention at issue on appeal discloses defining a process by a plurality of pages defined in a mark-up language (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. Data processing apparatus having processing means, memory means and display means,

wherein said processing means performs a process in response to program instructions read from said memory means via dynamically linked operational objects called by control objects, such that events are returned back to a calling control object;

a plurality of pages are defined in a mark-up language that are selectively displayed and executed by a controlled browser;

said controlled browser is controlled by a controlling container object;

active control objects for calling said operational objects are contained within said container object;

a single pass-through object is created;

at least one of said pages includes a page embedded control object configured to call said passthrough object;

an initiating one of said page embedded objects calls said passthrough object and passes to said passthrough object output information detailing a desired call to a specified operational object;

said passthrough object interprets output information received from a page embedded object to generate a call to a contained object that in turn calls the desired operational object;

said passthrough object receives event data from a called operational object and returns input data to said initiating embedded object indicative of said returned event.

C. REFERENCES

The Examiner relies on the following references as evidence:

Shima US 6,381,507 B1 Apr. 30, 2002
(filed May 31, 2000)

D. REJECTIONS

The Examiner makes the following rejection:

Claims 1-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shima.

II. ISSUE

Has the Examiner made a sufficient showing of obviousness under 35 U.S.C. § 103(a)?

III. PRINCIPLES OF LAW

I. Scope of Claim

The claim construction analysis begins with the words of the claim.

See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003). The presumption will be overcome where the patentee, acting as his own lexicographer, has set forth a definition for the term different from its ordinary and customary meaning or where the patentee has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope. *Id.* at 1298-99. Our reviewing court has established that the words in claims should be defined as they are disclosed in the specification before resorting to their dictionary definitions. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc).

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1739). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1741).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

With respect to independent claim 1, Appellants argue that the actual claim language has not been shown or suggested in the Shima reference and therefore the claimed invention would not have been obvious to one of ordinary skill in the relevant art at the time of the invention. (App. Br. 24). We agree with Appellants, and we find that the Examiner's indirect methodology to set forth the correlation of Appellants' claim language to the reference does not adequately set forth a sufficient initial showing of obviousness. The Examiner maintains that while Shima teaches that a pass-through functionality in the display device, Shima does not specifically state that the pages in a mark-up language were displayed in a browser. The Examiner further maintains, that since Shima teaches that the user interface is implemented within the intelligent controller that is coupled within the network system and has basic input and display capabilities, it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the Shima system to include a browser and mark-up pages. (Ans. 10-11). While the Examiner stretches the teachings of Shima to reconstruct the claimed invention, the Examiner does not address how the "pass-through functionality" would be impacted with this change of functionality. Appellants have disclosed that the "pass-through object" resolves the problem of lost data when the displayed pages are changed. Furthermore, while the Examiner has identified a disclosure in Shima of a "pass-through functionality," we cannot agree with the Examiner that this is equivalent to the claimed "pass-through object" which receives data as an intermediary between the browser and the input/output functionalities.

In Shima, the command pass-through functionality/mechanism is used to avoid the cumbersome control and manipulation of the user interface of the panel subunit. (Shima, Abstract and column 2). Shima further discloses at columns 3-4 that the command pass-through mechanism can be used to communicate the focus (cursor) navigation commands to the target. When the command keys (up/down/left/right, etc.) are pressed by the user, a pass-through command code and the appropriate action identifier are communicated to the target device. The target device would be able to transfer an exact bitmap of what is to be displayed. Thereby, the target device can guarantee that the rendered display will not be altered or modified by the controller.

While the Examiner has found similar words in the Shima reference for the “pass-through object” of the claimed invention, the pass-through mechanism of Shima does not carry out the specific functions as recited in independent claim 1 where a page embedded control object is configured to call said pass-through object and where the input and output information are passed through the pass-through object, as claimed.

The Examiner disagrees with Appellants' argument that because Shima is capable of having multiple entities with path pass-through functionality this does not mean that a single pass-through object can be created. The Examiner maintains that there is no evidence in Shima asserting that only multiple objects can be created and precluding a single pass-through object. (Ans. 12). The Examiner further maintains with respect to dependent claim 6 that the Shima system receives a pass-through command code in addition to the user interaction command code. The

Examiner reasons that the pass-through command code is communicated to the target device in conjunction with an action identifier that maps it to a predefined target command. Thus only one pass-through object exists at any time. (*Id.* at 6-7). We find the Examiner's reasoning to be unavailing.

Furthermore, the Examiner's position seems to evidence that the Examiner refers to the communicated command as the pass-through object each time a command is passed through the pass-through mechanism. But this interpretation does not support the Examiner's prior discussion with respect to independent claim 1. The Examiner's rejection of dependent claim 6 further evidences the Examiner's unreasonable claim interpretation or the Examiner's lack of a corresponding detailed explanation of the correlation of the teachings of Shima to the express language recited in independent claim 1. Hence, we find the Examiner's showing to be lacking with respect to independent claim 1 wherein the Examiner has not shown the existence of a single pass-through object which is created and performs the bidirectional communications as set forth in independent claim 1 and dependent claims 2-11 which contain the same limitations.

Independent claims 12 and 21 and their respective dependent claims 13-20 and 22-27 contain similar limitations which have not been properly rejected under 35 U.S.C. § 103(a) for the same reasons discussed *supra* regarding claim 1.

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V. CONCLUSION

For the aforementioned reasons, the Examiner has not shown a sufficient showing of obviousness under 35 U.S.C. § 103(a) of the invention as recited in claims 1-27.

VI. ORDER

We reverse the obviousness rejections of claims 1-27.

REVERSED

msc

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